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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/050,556

01/18/2002

Kyoko Kimpara

072982-0233

6102

22428

7590

09/14/2005

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

VO, HUYEN X

ART UNIT

PAPER NUMBER

2655

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/050,556

Applicant(s)

KIMPARA, KYOKO

Examiner

Huyen X. Vo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 2 and 9 are objected to because of the following informalities: the phrase "permits to the terminal two processes" is believed to be in error. Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 14-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Claims 14-15 are drawn to a "program" *per se* as recited in the preamble and as such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data

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structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-4, 6-8, 10-11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata et al. (US 5987402) in view of Franz et al. (US 6356865).

7. Regarding claims 1 and 8, Murata et al. disclose a translation server and method connected to a user terminal via a network, comprising: an input information controller for receiving a translation instruction sent from the terminal, the translation instruction

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including location information representing a location of an object document to be translated, source language information representing an source language of the object document and target language information representing a translation target language of the object document, and obtaining the object document to be translated from a Web server on the basis of the location information (*col. 38 to col. 6, line 17, language information is determined by Check Language unit 307 in figure 4*); an information separator for separating the object document sent from the input information controller into a translation object part and a non-translation object part (*col. 6, lines 20-48*); a translator for translating the translation object part sent from the information separator according to the source language information and the target language information to obtain a translation result (*col. 6, line 20 to col. 7, line 49*); an information converter for producing a retranslation instruction part for permitting the terminal to display a language information input column for inputting the source language information and the target language information by the user and a retranslation instruction input part and to send the translation instruction including the source language information and the target language information in the language information input column and the location information of the object document to be translated to the translation server (*col. 9, lines 36 to col. 11, line 40 and/or referring to figures 7-11*).

Murata et al. fail to specifically disclose an information synthesizer for synthesizing the translation result sent from the translator, the retranslation instruction part produced by the information converter and the non-translation object part sent from the information separator and sending a synthesized result to the terminal. However,

Franz et al. teach an information synthesizer for synthesizing the translation result sent from the translator, the retranslation instruction part produced by the information converter and the non-translation object part sent from the information separator and sending a synthesized result to the terminal (*Speech Synthesis 1216 in figure 12*).

Since Murata et al. and Franz et al. are analogous art because they are from the same field of endeavors, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Murata et al. by incorporating the teaching of Franz et al. in order to provide audible output of the translated document to users.

8. Regarding claims 3 and 10, Murata et al. further disclose that the information converter converts from link target document location information representing a location of a link target document included in the non-translation object part to a link target document translation instruction part for permitting the terminal to send the translation instruction including the source language information and the target language information in the language information input column and the link target document location information to translation server when the link target document is selected, the information synthesizer synthesizes the translation result sent from the translator, the retranslation instruction part produced by the information converter and the converted non-translation object part after the conversion of the link target document location information into the link target document translation instruction part in the information converter and sends a synthesized result to the terminal (*col. 9, lines 36 to col. 11, line 40 and/or referring to figures 7-11*).

9. Regarding claims 4, 6-7, 11, and 13, Murata et al. further disclose that the object document to be translated is a hypertext markup language document, wherein the translation object part is a text part (*col. 6, lines 20-67*), wherein the non-translation object part is a tag part (*col. 5, lines 5-12*).

10. Claims 2, 5, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata et al. (US 5987402) in view of Franz et al. (US 6356865), and further in view of Fushimoto et al. (US 5742505).

11. Regarding claims 2 and 9, the modified Murata et al. fail to specifically disclose the translation server and method claimed in claims 1 and 8, respectively, wherein the language information input column includes an source language information list box for selectively containing one of a plurality of source language information and a target language information list box for selectively containing one of a plurality of target language information and the information converter sets or resets at least the source language information and the target language information of the translation instruction as initial values to the source language information list box and the target language information list box, respectively, and permits the terminal to processes that are producing the retranslation instruction part for permitting the terminal display and sending to the translation server described in claim 1. However, Fushimoto et al. teach

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a box containing a list of source languages and target languages readily available for user selection (*figures 14, 17 and 18A-C*).

Since the modified Murata et al. and Fushimoto et al. are analogous art because they are from the same field of endeavors, it would have been obvious to one of ordinary skill in the art at the time of invention to further modify Murata et al. by incorporating the teaching of Fushimoto et al. in order to enable the users of different nationalities to use the system.

12. Regarding claims 5 and 12, Murata et al. further disclose that the object document to be translated is a hypertext markup language document, wherein the translation object part is a text part (*col. 6, lines 20-67*), wherein the non-translation object part is a tag part (*col. 5, lines 5-12*).

Conclusion

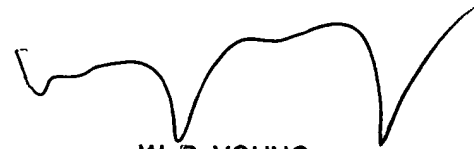
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huyen X. Vo whose telephone number is 571-272-7631. The examiner can normally be reached on M-F, 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571-272-7582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HXV

8/17/2005



W. R. YOUNG
PRIMARY EXAMINER